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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,930	01/30/2004	Jerome R. Mahoney	IVC-114A	7793

7590
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11/16/2007

EXAMINER

WIN, AUNG T

ART UNIT	PAPER NUMBER
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2617

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/768,930	Applicant(s) MAHONEY, JEROME R.	
	Examiner Aung T. Win	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/20/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 1-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 08/20/2007 have been fully considered but they are not persuasive. Applicant argues that Modified method and system in combination with prior arts Mariano et al, Rapchak and Kobayashi et al would not provide applicant's claimed method and system. However, it should be noted that claims are rejected based on modification of prior arts Mariano et al, Shizuka et al and Kobayashi. Therefore, modifying Mariano's system and method of communicating prescription medicine instructions to patient with the teaching of Shizuka et al and Kobayashi would teach claimed system and method consisting of claimed steps [See rejections stated below].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 38-40, 42-45 & 47-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mariano et al. (US 20030156724A1) in view of Shizuka et al. (US20030014252A1), further in view of Kobayashi et al. (US20060116780A1).

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2.1 Regarding Claim 38 & 40, Mariano discloses a method of communicating prescription medicine instructions to patient, consisting of:

Providing a medicine container, said medicine container including a storage area for medicine [Figure 1 & 2], and microprocessor [microprocessor: 0031] including:

voice instructions receiving chip [infrared or radio receiver: 0038 & 0043];

voice instructions storage means [electric storage device: 0031 & 0038];

voice instructions playback means [sound player 30: 0029, 0030, 0031];

voice instructions playback start means [activating member 40: 0030]; and

a power supply adapted to power components of sound player [battery 80:

0031].

and

Providing a central processor that is a computer system separate from said medicine container [Computing Unit running computer speech software: 0037] for recording voice instructions and further transmitting the recorded voice instructions wirelessly. Mariano does not explicitly teach all limitations as claimed but Mariano teaches receiving recorded voice instructions wirelessly and storing recorded voice instructions in medicine container with playback device for further playback especially intended for visually impaired user [Paragraph 0027-0031].

Shizuka discloses a method of creating audio file with a computer system including:

Computer user input means selected from keyboard, mouse, ball and touchpad for receiving text data input from user [inputting text data using text input unit of known computers: 0009];

Text to speech means [Speech generating unit to generate speech data corresponding to the text data: 0009];

Audio file means to create audio file from said text-to-speech means [file creation unit: 0009].

Shizuka also discloses that created audio files can be wirelessly transmitted to other wireless devices [0197]. It is obvious to one of ordinary skill in the art that audio files as disclosed by Shizuka must be transmitted with identifier as claimed in order to retrieve identified stored audio files. Shizuka also discloses that text-to-speech converting means are well known techniques [0005].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to modify Mariano voice medicine instruction transmitting and receiving method as taught by Shizuka to create audio file prescription medicine instruction from user input text and to transmit to the medicine container for storing the transmitted audio file medicine instruction and for playing back the wave file as claimed. One of ordinary skill in the art at the time of invention of made to do this to provide audio file creating method from text for providing standardized speech medication instruction for providing medication instruction with clarity.

Modified method does not explicitly disclose creating wave file from text and transmitting wave file. It should be noted that concept and advantages of claimed

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feature i.e., creating wave file from text is obvious to one of ordinary skill in the art because various computing software to convert text-to-wave are also very well known to one of ordinary skill in the art at the time of invention of made.

Kobayashi also discloses recording, saving and transmitting wave files wirelessly from computer [the transmission of digital audio wave file can be performed by a radio or infra-red transmitter: 0122 & 0113] [Abstract: Digital audio data can be transferred from the computer]. Kobayashi also teaches that audio files are recorded in with file numbers and the reproduction unit comprises menu button and file button for reading out file numbers of digital data files [0112].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to further modify the method as cited in Claim 1 steps (a) –(j) to transmit audio wave file and to implement accessing means in medicine container as claimed in Step J with utilizing file button as taught by Kobayashi. One of ordinary skill in the art at the time of invention of made to do this to transmit general wave sound file that can be reproduced wave file directly with no additional computing software and easy access to downloaded wave file for further reproduction.

2.2 Claims 42, 43 & 45 are the method claim rejected for the same reason as stated above in Claim 38 rejection because claimed methods substantially read on the corresponding method of Claim 38.

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2.3 Claims 47, 48, 50, 51, 52 & 54 are the apparatus claims rejected for the same reason as stated above in Claim 38 rejection because claimed means executes processing steps which are substantially close to the corresponding method of Claim 38.

2.4 Claims 39, 44, 49 & 53 are rejected for the same reason as stated above in Claim 38, 42, 47 & 51 rejections [Mariano: sound player includes microprocessor is attached to medicine container: Figure 2 & 0031]

2. Claims 41 & 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mariano et al. (US 20030156724A1) in view of Shizuka et al. (US20030014252A1), further in view of Kobayashi et al. (US20060116780A1) and Forman (US20050086077A1) and Moore (US005983182A).

3.1 Regarding Claims 41 & 46, modified method teaches converting selected electronic text file to voice using computer [Shizuka: Figure 50 & 51]. It should be noted that claimed selecting step is very well known to one of ordinary skill in the pharmaceutical art at the time of invention of made because claimed preset data collection of prescription medicine instructions corresponding to a specific medication and dosage combination are stored in the processing computer memory or database for pharmacist to prepare medication instructions.

Forman teaches selecting medication for generating prescription with in printed text or electronic format [saved electronic file: 0015]. Forman teaches that software is configured in a way so that the user can select medications and further to add instructions regarding selected medicines which can be saved in electronic file [See Figures].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to further modify the method as generate instruction using computing software as taught by Forman in saving preparing prescription in electronic file format. One of ordinary skill in the art at the time of invention of made to do this to provide medication instructions in electronic format.

The system and method as modified does not explicitly teaches selecting method as claimed although Forman teaches selecting medicine name for preparing prescriptions instructions for patients. Moore teaches computer-based system used by pharmacists to retrieve prestored medicine instructions including medications and different dosages corresponding to a specific medication [Column 1, Line 55-60]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to further modify computing system to preload prescriptions instructions corresponding to prescribed medicine as taught by Moore. One of ordinary skill in the art at the time of invention of made would have been motivated to do this to assist pharmacist in providing correct medication information to patients.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Glynn et al. US20050199526A1

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aung T. Win whose telephone number is (571) 272-7549. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571) 272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aung T. Win
Group Art Unit 2617
November 9, 2007


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